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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,458	08/15/2005	Suman K. Chopra	IR 7419-00	2143

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/642,458	Applicant(s) CHOPRA ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 5, 7 to 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 5, 7 to 11, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained from the previous office action. Applicants have not addressed this issue. Specifically, the terms “the diorganosiloxane” and “the adhesion enhancing agent” lack antecedent basis.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 to 3, 8 to 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/34221, herein ‘221, and WO 01/01942, herein ‘942 for reasons of record.

Applicants are of the belief that the silicone resin/gum/fluid used in ‘221 and ‘942 is not a pressure sensitive adhesive. This is not persuasive. This composition adheres to surfaces, making it an adhesive, and is applied to the surface by use of an applicator or by use of the finger, both of which require the application of some pressure. As such the silicone resins in ‘221 and ‘942 can be considered pressure sensitive adhesives.

Applicants argue that the references do not teach a pressure sensitive adhesive “such as one obtained by the condensation of a silicone resin and an organosiloxane” and the Examiner has already acknowledged this by not including claim 7 in this rejection. The silicone resin based pressure sensitive adhesive in claim 1, however, is not limited to such adhesives.

Applicants stress the fact that the silicone resins in ‘942 and ‘221 form a rigid or hard film but this does not mean that they are not considered to be pressure sensitive adhesives. There is nothing in the instant claims or in the term “pressure sensitive adhesive” per se that imports any elastic or tacky requirements to the silicone resin in claim 1.

On page 3 of their response, applicants traverse “the objection to claim 10 that the term “adhesion enhancing agent” is extremely broad”. In fact, the Examiner does

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not “object” to this term as being extremely broad; she merely noted that it *is* extremely broad and encompasses any number of components. This term is not limited by the teachings on page 4, line 11, to page 5, line 8.

4. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by WO '942.

This rejection relies on the rationale of record. Applicants' traversal is consistent is consistent with that noted supra regarding the pressure sensitive adhesive. Since such arguments are not persuasive, this rejection is maintained.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '221.

This rejection relies on the rationale of record. Applicants' traversal is consistent is consistent with that noted supra regarding the pressure sensitive adhesive. Since such arguments are not persuasive, this rejection is maintained.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '221 as applied to claim 1 above, and further in view of Shiraeff.

Applicants traverse this rejection by stating that Shiraeff contains no teaching PVP/H₂O₂ could be used as a whitening agent in pressure sensitive silicone resin based adhesive tooth whitening systems. The Examiner agrees. But this does not mean that the addition of PVP/H₂O₂ to a silicone resin based adhesive tooth whitening systems would not have been obvious to one having ordinary skill in the art. Shiraeff teaches the benefits of stabilizing hydrogen peroxide with PVP and 'WO 221 teaches including hydrogen peroxide in the silicone resin based adhesive tooth whitening systems. Thus in an effort to improve long term stability the skilled artisan would have been motivated to use the hydrogen peroxide in '221 as a blend with PVP. It is prima facie obvious to add a known ingredient to a known composition for its known function. Motivation to make this combination relies on much more than the argued “obvious to try” rationale. The Examiner stresses that she did not argue an “obvious to try” standard in this rejection.

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7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by WO '472 for reasons of record.

Again applicants appear to be reading something into the term pressure sensitive silicone resin based adhesive that is not there. The whitening strip in '472 can include silicone adhesives. Such a strip adheres to teeth by exerting pressure and this does render the adhesive therein pressure sensitive.

8. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over '472 as applied to claim 1 above, and further in view of WO '221.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over '472 as applied to claim 1, above, and further in view of Shiraeff.

These rejections are maintained for reasons of record. Applicants' traversal relies on the term "pressure sensitive silicone resin based adhesive" and for reasons noted supra this is not sufficient to distinguish the instant claims from the prior art.

10. Claims 7 to 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over '472 as applied to claim 1, supra, and further in view of Pfister et al.

This rejection relies on rationale of record. Upon reading '472 the skilled artisan would have been motivated to use, as the silicone adhesive therein, known silicone adhesives having use in the medical field, particular one known to be compatible with drugs and excipients. Thus one would have turned to the teachings of Pfister et al. to select an appropriate silicone adhesive, thereby rendering obvious the instant claims. Contrary to that argued by applicants, the Examiner has not ignored the fact that Pfister et al. fail to teach oral care application. The fact that it can be used in medical applications to deliver drugs and/or active ingredients make the teachings of Pfister et al. analogous art with '472.

Again the Examiner notes that the term "adhesion enhancing agent" is quite broad and is met by agents which enable the adhesive to be retained intact on the skin

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(since this would enhance the adhesive property). As such the cohesive strengthening agent meets claim 10.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over '472.

This rejection relies on rationale of record. Applicants rely on the silicone resin based pressure sensitive adhesive requirement in an effort to overcome this rejection. As noted supra, this is not persuasive and as such this rejection is maintained.

12. Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest the combination of components found in claim 1 in combination with a polyethylene gelled mineral oil or a petrolatum adhesion enhancing agent as required by these claims.

14. In conclusion, applicants appear to be reading more into the instant claims, particularly into the term pressure sensitive silicone resin based adhesive, than what is found in the claims. Applicants believe that this term distinguishes the claims from the prior art, but this on its own is insufficient.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
3/10/05